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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ANTHONY EDWARD MARTINEZ

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Appeal 2007-4336  
Application 09/657,116  
Technology Center 2100

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Decided: July 8, 2008

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Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and  
THU A..DANG, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

## BACKGROUND

Appellant's invention relates to a spotlight cursor for use in selecting secondary contact for display. (Spec. 1). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A programmable apparatus for displaying secondary content, comprising:

a computer;

a software program for displaying a spotlight cursor having a circumference;

the computer being directed to display secondary content when said secondary content is covered by a point on said circumference;  
and

wherein the secondary content is displayed without user interaction.

## PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Lehikoinen	US 6,559,872 B1	May 6, 2006
Clark	US 5,995,101	Nov. 30, 1999

## REJECTIONS

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lehikoinen in view of Clark.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellant regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed October 31, 2005) for the reasoning in support of the rejections, and to the Appellants' second amended Brief (filed August 7, 2006) and Reply Brief (filed December 22, 2005) for the arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellant's Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellant and the Examiner. As a consequence of our review, we make the determinations that follow.

#### *35 U.S.C. § 103(a)*

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *Id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield

predictable results." *Id.* The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* (citing *KSR*, 127 S. Ct. at 1740-41).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

With respect to independent claim 1, from our review of the teachings of Lehtikoinen and the Examiner's stated rejection at pages 3 and 8-9 in the Answer, we find that the Examiner has set forth a proper initial showing of obviousness of independent claim 1. Therefore, we look to Appellant's Briefs to show error in the Examiner's initial showing of obviousness.

At the outset, we are unclear as to the specific arguments set forth with respective claims in Appellant's Brief since Appellant does not appear to have set forth the arguments clearly with respect to 37 CFR § 41.37(c)(1)(v). Therefore, we will succinctly attempt to address Appellant's arguments as they apply to the listed grounds of rejection to be reviewed on appeal as set forth in section VII of Appellant's Brief at page 9.

Specifically, with respect to ground A: we do not find the express limitation of the "cursor having a circumference" in the claim language since Appellant argues subsequently that the "spotlight cursor" is distinguishable from the ordinary and customary "cursor." Therefore, that broad argument is not commensurate in scope with the express language of independent claim 1.

With respect to ground B: Appellant argues that Lehtikoinen does not teach or suggest a circumference that is not visible. We do not find a limitation in independent claim 7 specifically reciting the circumference not being visible. Therefore, Appellant's argument is not commensurate in scope of the express language of independent claim 7. Therefore, this argument is not persuasive of error in the Examiner's initial showing of obviousness.

With respect to ground C: Appellant argues that Clark does not teach or suggest a cursor that displays secondary content "without user interaction." Here, we do not find Appellant's argument persuasive of error since Appellant's invention requires movement of a spotlight cursor to a location as does the system of Clark. We find similar user interaction to the

extent described in Appellant's Specification. Therefore, Appellant's argument is not persuasive of error in the Examiner's initial showing of obviousness.

With respect to ground D: Appellant argues that the combination of Lehtikoinen and Clark does not teach or suggest a "cursor having a circumference that displays secondary content without user interaction." Again, we find that independent claim 1 sets forth a "spotlight cursor" rather than merely a "cursor" as Appellant has attempted to distinguish a "cursor" from a "spotlight cursor."

Moreover, independent claim 11 does not specifically recite a "spotlight cursor" nor a "circumference," but sets forth a "peripheral area around a cursor." Therefore, Appellant's argument is not commensurate in scope with independent claim 11.

Additionally, we note that independent claim 8 sets forth a "method for creating a spotlight cursor," yet the steps of independent claim 8 do not set forth creating the spotlight cursor, but rather the use thereof for display of secondary content. In further prosecution, the Examiner should reevaluate independent claim 8.

From our review of Appellant's Brief and Reply Brief, we note that Appellant argues and describes the claimed invention with respect to the limitation "to display secondary content without user interaction." (App. Br. 2). Yet, a majority of Appellant's arguments are directed to claim construction and inferentially defining the terms "cursor" and "spotlight cursor" wherein a cursor is intended to convey a movable visible shaped input device on the display. (App. Br. 12-15). Additionally, Appellant

maintains that the term "spotlight cursor" should be given specific meaning as stated by Appellant in the Specification. (App. Br.13). Yet, Appellant has identified no express and specific definition in the Specification for the term "spotlight cursor." At best, Appellant has identified that the Specification states that

[s]potlight cursor 320 has light 314, cursor 311 and "c" 330. Cursor 311 has tip 312.... Persons skilled in the art are aware that any other point on the cursor could be chosen. Tip 312 defines the center of light 314. Light 314 is an area defined by a circle with circumference "c" 330.

(Spec. 5).

Here, we note that the invention of Lehtikoinen is described with respect to computing devices that can be carried or worn such as a personal digital assistance (PDA) which allows computing anytime and anywhere. (Lehtikoinen col. 2, ll. 48-52). Therefore, we find the description of Lehtikoinen's cursor to be slightly different than the ordinary and customary definition which may be attributable to the fact that the definition appears to be based on a personal computer (PC)-based system, but we still find similar functionality in both. Therefore, we find the use of the term "cursor" by Lehtikoinen to be within the ordinary customary definition.

We further find that while Lehtikoinen does not specifically state how the "reference location" for the center of the circle is set, it is clear to those skilled in the art that the center may be varied. (Col. 1, ll. 45-55). Therefore, we find that the position of the center of the circle may be changed. It is movable as in Appellant's proffered definition of the term



“cursor.” Yet, in the described embodiment of Lehtikoinen, the center of the circle is less frequently moved than in an ordinary PC-based computer system.

Here, we find Appellant’s asserted definition of a “spotlight cursor having a circumference” to go beyond the express limitations recited in independent claim 1, and we do not find that Appellant’s Specification specifically defines the claim term “spotlight cursor.” We find that all the attributes of the “spotlight cursor” set forth in Appellant’s Specification goes further to identify all the variations in the set up of the spotlight cursor which are not necessarily imputed to the term “spotlight cursor”. (See independent claim 7).

We find that the teachings of Lehtikoinen are sufficient to meet the limitations of independent claim 1, wherein Lehtikoinen teaches a programmable apparatus for displaying secondary content about an object, using a selection circle which would inherently have a circumference. The selection is performed by the selection circle which is the “cursor” for performing selection function. Furthermore, the secondary content is displayed without any further user interaction than selecting the object.

With respect to the limitation “without user interaction” as recited in independent claim 1, we find no express definition or description in Appellant’s originally filed Specification or the Amended Specification. Furthermore, we are unclear as to how the Appellant intends this limitation to be interpreted since the user of Appellant’s invention must move a spotlight cursor in the two-dimensional space to select those portions of the display which may have secondary content to be displayed. Therefore,

Appellant's invention requires user interaction to place the "cursor" or "spotlight cursor" in or over the appropriate locations on the display. In comparison to the selection methodology of Lehtikoinen, there is still some user interaction in Appellant's claimed invention to display the secondary content. Therefore, Appellants' argument is not persuasive of error in the Examiner's initial showing of obviousness.

Appellant argues that the system of Clark does not support the rejection of the limitation "without user interaction" because the user must first place the cursor onto the visible icon and then keep the cursor on the icon for a predetermined interval which requires "user interaction." (App. Br. 23). As discussed above, we do not find Appellant's argument persuasive of error since Appellant's spotlight cursor must also be moved and placed at a location. Therefore, we find that Appellant's claimed invention also requires some user interaction.

With respect to Appellant's interpretation of the claim language and the definition of cursor, spotlight cursor and the distinction that the center of the circle of Lehtikoinen is not moved by the user (App. Br. 16 and Reply Br. 2) and that Lehtikoinen does not disclose a circumference that is attached to a cursor (App. Br. 16 and 17), we do not find Appellant's arguments and interpretation to be commensurate in scope with the express language of independent claim 1 since we find no recitation of that a separate cursor is attached to a spotlight cursor or that the center of the circle must be moved by a user. Additionally, this argument implies that the claimed invention necessarily would require user interaction for movement which seems to be prohibited by the express language of independent claim 1 reciting "without

user interaction." Since we find no persuasive showing of error in the Examiner's initial showing of obviousness, we will sustain the rejection of independent claim 1 and its dependent claims.

Alternatively, as a further basis to affirm the rejection of all claims, we find that independent claim 11 does not recite the argued claim terminology "spotlight cursor," nor any of the other implied limitations which Appellant seeks to interpret into independent claim 1. Also, Appellant has set forth an apparatus for displaying secondary content in independent claim 1 rather than a methodology as set forth in independent claim 11. Moreover, since Appellant has not set forth specific headings in the Argument Section of the Brief with respect to any grouping of the claims, it is appropriate for the Board to select a representative claim and address it with respect to Appellant's arguments. The only headings we find in Appellant's Brief are for independent claim 1 in section E.1. of the argument section, independent claim 7 and dependent claims 4 and 5 in section E.2. of the argument section VIII of the Brief. Therefore, independent claim 11 would be grouped with independent claim 1. Accordingly, the Board may select independent claim 11 as the representative claim for this grouping, and find that Appellant's arguments are not commensurate in scope with the language of independent claim 11. Therefore, these arguments are not persuasive of error in the Examiner's initial showing of obviousness based on the combination of Lehikoinen and Clark.

Additionally, with respect the method of independent claim 11, if we interpret the teachings of Lehikoinen to teach that the "cursor" is the selection circle with the reference point, then the secondary content is displayed upon a determination that the selection circle (peripheral area) intersects the item/object. Here, we find that the teachings of Lehikoinen are clearly suggestive of a circular selection cursor.

With respect to dependent claim 4, Appellant merely argues that there is no evidence to support the Examiner's basis of the rejection in the cited portion of the reference. While we agree with Appellant that the Examiner's reliance upon the variable circumference does not expressly teach "the light within the circumference is of selectable and variable intensity" as recited in dependent claim 4, we do not find express antecedent basis for the light within the circumference in independent claim 1. Yet, we do agree with the Examiner's reliance and discussion with respect to dependent claim 5 concerning the color within the circumference to be pre-selectable based upon the user's desktop settings. (Ans. 4 and 8). Here, we find that the color would have been a "light" which is selectable and variable depending upon the user's settings. Therefore, we do not find Appellant's argument of a lack of evidence to be persuasive of error in the Examiner's initial showing of obviousness. Accordingly, we will sustain the rejection of dependent claim 4.

With respect to dependent claim 5, Appellant again argues that there is no evidence to support the Examiner's basis of the rejection. Again, we disagree with Appellant and find the Examiner's rejection to be reasonable in light of the broad claim language. Appellant argues that a circle does not

necessarily have color. (App. Br. 22). We disagree with Appellant and find that every element on a display screen would necessarily have some attribute to be visible, whether by color itself or a transition between colors.

Therefore, we do not find Appellant's argument persuasive of error in the Examiner's initial showing of obviousness. Accordingly, we will sustain the rejection of dependent claim 5.

With respect to independent claim 7, Appellant reiterated the arguments/positions of the parties, but does not set forth a reasoned argument showing error in the Examiner's initial showing of obviousness. Since we find no persuasive showing of error in the Examiner's initial showing of obviousness, we will sustain the rejection of independent claim 7 and its dependent claims.

With respect to independent claims 1, 6, 7, 8, and 11, Appellant argues that the teachings of Clark require user interaction and therefore do not support the rejection of the limitation "without user interaction." We disagree with Appellant as discussed above and do not find this argument to be persuasive of error.

Appellant argues that the Examiner did not show how a person skilled in the art confronted with the same problems as the inventor, with no knowledge of the claimed invention, would select the elements from the cited prior or teachings for the combination in the manner claimed.

Appellant further contends that the Examiner has relied upon hindsight and the Examiner has not provided evidence of a suggestion, teaching, or motivation to combine the relevant teachings. (App. Br. 23-24). We disagree with Appellant and find that the Examiner has set forth a reasoned

motivation for the combination at page 3 of the Answer and do not find that Appellant has persuaded us of error in the stated motivation. Here, it appears that Appellant is reading more into the express limitations of the independent claims than is reasonable in light of the broad disclosure set forth in Appellant's Specification. Therefore, we do not find that the Appellant has shown error in the Examiner's initial showing of obviousness. Accordingly, we will alternatively sustain the rejection of both independent claim 1 and independent claim 11, and independent claims 1, 6, 7, 8, 11, and 16 grouped therewith by Appellant and dependent claims 2, 3, 9, 10, 12-15, and 17, 20 grouped therewith by Appellant since Appellant has not set forth separate arguments for patentability.

#### CONCLUSION

To summarize, we have sustained the rejection of claims 1-20 under 35 U.S.C. § 103(a).

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Application 09/657,116

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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